APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,075	09/13/2007	Manuel Angel Albarran Moyo	200312215-3	2399

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EXAMINER
PHAM, KHANH B

ART UNIT	PAPER NUMBER
2166	

NOTIFICATION DATE	DELIVERY MODE
04/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 March 2010</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>15-38</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>15-38</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 32 lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   **Claims 15-22, 31-38** are rejected under 35 U.S.C. 102(e) as being anticipated by
Lapstun et al. (US 7,623,713 B2), hereinafter "**Lapstun**".

        As per claim 15, Lapstun teaches a computer program product for generating an
electronic document comprising:

- "a computer usable medium having computer usable program code embodied
  therewith, the computer usable program code comprising: computer usable program
  code configured to defined the electronic document" at Col. 7 lines 20-30;

- "in which the computer usable program code comprises first and second portions of
  data" at Col. 7 lines 20-53;

- "in which the first portion of data defines the content of the electronic document" at
  Col. 7 lines 20-25;

- "and the second portion comprises data relating to a pattern of position identification
  marking such that when the electronic document is printed, a pattern reading device
  is able to determined its position relative to position identification marking" at Col. 9
  line 60 to Col. 10 line 13;

- "in which the computer usable program code comprises a single data file with the
  first and second data portions being embedded within the data file" at Col. 14 lines
  11-67.

        As per claim 16, Lapstun teaches the computer program product of claim 15
which is written such that the computer usable program code can be converted from

one format to other formats without losing any of the information from the electronic

document" at Col. 31 lines 25-50.

As per claim 17, Lapstun teaches the computer program product of claim 15, in

which "the second portion of data comprises metadata and in which the computer

useable program code includes one or more controls which control the way in which the

second portion of data is converted between formats to preserve the pattern" at Col. 11

lines 20-65 and Col. 31 lines 25-50.

As per claim 18, Lapstun teaches the computer program product of claim 16, in

which the second portion of data comprises metadata and in which the computer usable

program code includes one or more controls which control the way in which the second

portion of data is converted between formats to preserved the pattern" at Col. 11 lines

20-65 and Col. 31 lines 25-50.

As per claim 19, Lapstun teaches the computer program product of claim 15, in

which the data in the second portion comprises anyone or more of the following:

data from which an algorithm or the like can generate the pattern; co-ordinates or other

metadata identifying the portion of the position identification marking" at Col. 12 lines

10-65.

As per claim 20, Lapstun teaches the computer product of claim 16, in which

"the data in the second portion comprises anyone or more of the following: data from

which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

     As per claim 21, Lapstun teaches the computer program product of claim 17, in which "the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

     As per claim 22, Lapstun teaches the computer program product of claim 18, in which "the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking"at Col. 12 lines 10-65.

     As per claim 23, Lapstun teaches the computer program product of claim 15, in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

     As per claim 24, Lapstun teaches the program product of claim 16 in which "the at least one portion providing the position of the position identification markings within

the electronic document and/or data identifying the content of the position identification

marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 31, Lapstun teaches the program product of claim 15 in which "a

schema is provided" at Col. 30 lines 5-40.

As per claim 32, Lapstun teaches a system for producing electronic documents

comprising:

- "mean for receiving the content of the electronic document" at Col. 9 lines 45-55
  and Figs. 1, 25-26;

- "means for receiving data defining a pattern of positional markings allocated to at
  least a portion of the document" at Col. 9 line 66 to Col. 10 line 13;

- "means for generating data structure defining the electronic document which data
  structure comprises first and second portion of data, the first portion of data
  defining the content and the second portion of data relating to the pattern" at
  Col. 14 lines 10-67 and Figs. 1, 25-26.

As per claim 33, Lapstun teaches a method for generating an electronic

document comprising:

- "creating an electronic file and storing in that file data and metadata, the data
  defining at least some content" at Col. 9 lines 45-55 and Figs. 1, 25-26;

- "and the metadata relating to a pattern of position identification markings arranged to allow a pattern reading device to determined its position within the position identification markings" at Col. 9 line 66 to Col. 10 line 13,

- "the electronic file capable of generating an electronic document" at Col. 14 lines 10-67 and Figs. 1, 25-26.

As per claim 34, Lapstun teaches the method of claim 33, in which "a file embedding mechanism is used to embed metadata within the electronic document" at Col. 11 lines 20-65.

As per claim 35, Lapstun teaches the computer program product of claim 15, in which "the pattern reading device is a digital pen" at Col. 12 lines 12-22.

As per claim 36, Lapstun teaches the method of claim 33, in which "the pattern reading device is a digital pen" at Col. 12 lines 12-22.

As per claim 37, Lapstun teaches the computer program product of claim 31, in which "the schema is an XML schema" at Col. 30 lines 5-12.

As per claim 38, Lapstun teaches the method of claim 34, in which "the metadata is XML metadata" at Col. 30 lines 5-12.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 23-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lapstun as applied to claims 15-22, 31-38 above, and in view of Ethier et al. (US

7,653,876 B2), hereinafter "**Ethier**".

       As per claim 23-30, Ethier does not teach "the second portion of data is

provided in XML" as claimed. However, Either teaches an electronic document includes

a first portion and a second portion, wherein a second portion is provided in XML at Col.

3 lines 30-50. Thus, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to combine Ethier with Lapstun so that "the document

can be transformed back and forth between a binary format and a markup language

format without loss of desired information" as suggested by Ethier at Col. 4 lines 58-65.

Response to Arguments

9.   Applicant's arguments filed March 18, 2010 have been fully considered but they

are not persuasive. The examiner respectfully traverses applicant's arguments.

Rejection under 35 U.S.C §101:

In view of applicant's amendment to the specification. The 101 rejection to claim 15 has been withdrawn.

Regarding claim 32, applicant argued that the claim contain physical article or objects to constitute a machine or manufacture within the meaning of 35 U.S.C 101. However, all portions of the specification referred to by applicant indicate that the means recited in the claim are implemented using software, for example, "graphic user interface", "printer driver" are software components. Therefore, the claimed system recited in claim 32 is software per ser, lacks the physical article or objects to constitute a machine or manufacture within the meaning of 35 U.S.C 101.

Rejection under 35 U.S.C §102(e)

Regarding claims 15, 33, applicant argued that "Lapstun is silent on providing a single data file that includes these terminal elements within the data file". On the contrary, Lapstun clearly teaches at Col. 14 lines 11-67 the **page instance** 830 (i.e. "**single data file**"), which consists of "a set of terminal element instance" and the "Page ID 50" encoded in tags. Lapstun further teaches: "each page instance 830 describes a single unique printed netpage 1, and record the page ID 50 of the netpage" at Col. 14 lines 45-46. As seen at Fig. 1 reproduced below, each netpage is the printed copy of the page instance 830, and includes first portion (element 2 of Fig. 1) of data defines content of the document and second portion (element 3,4 of Fig. 1) comprises data relating to a pattern of position identification markings as claimed.
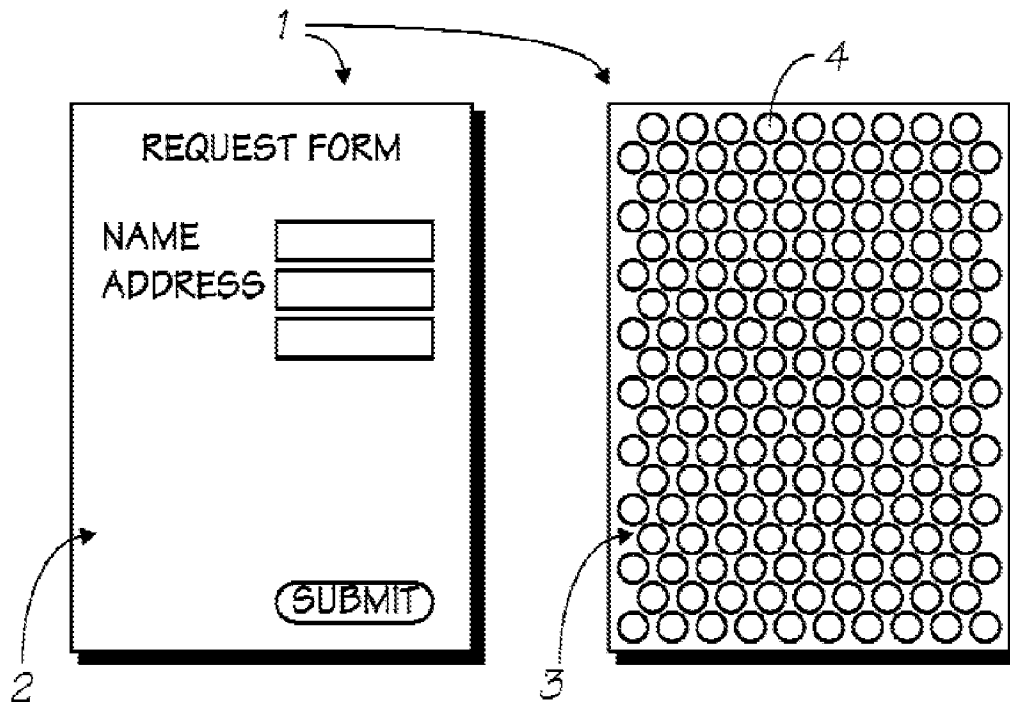
Regarding claim 32, Applicant argued that "Lapstun is silent on creating a single data file that includes content of the electronic document and data relating to a pattern of position identification marking" , it is noted that the features upon which applicant relies (i.e., "creating a single data file") are not recited in the rejected claim 32. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). On the other hand, as discussed above. Lapstun teaches the **page instance 830** (mapped to the claimed "**data structure**") comprise first and second portions of data and therefore anticipated the claimed limitation.

Regarding claims 17 and 18, Applicant argued that Lapstun only teaches converting the document from one format to another but does not teach "converting a second portion of data comprising metadata from one format to another". On the contrary, the examiner respectfully submits that Lapstun document includes first and second portions of data, therefore , converting the document from one format to another format is same as converting second portion of data from one format to another format as claimed.

Regarding claim 19-22, Applicant argued that Lapstun does not teach or suggest "in which the data in the second portion comprises any one or more of the following: data from which an algorithm can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking". On the contrary Lapstun teaches at Col. 12 lines 10-16 that each of the tag (i.e. "data in the second portion") is encoded with data which is used to identifying the portion of the position identification marking (i.e. scale, aspect ration, rotation, axis, spatial relationship, distortion etc.") Lapstun therefore teaches that the second portion comprise "other metadata identifying the portion of the position identification marking as claimed.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-

4116. The examiner can normally be reached on Monday through Friday 7:30am to

4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
Art Unit 2166

April 13 2010